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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,996	03/03/2004	Carmen Flosbach	FA1013 US DIV	4286
23906	7590	02/13/2006	EXAMINER	
E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1128 4417 LANCASTER PIKE WILMINGTON, DE 19805			TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,996

Applicant(s)

FLOSBACH ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12, 16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Amendment filed on 1/05/2006 has been entered. Claims 11-12, 16, 18-21 are pending in the application.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-12, 16, 18-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Duecoffre et al (US 6,063,448) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on August 3, 2004 because the coating agent Duecoffre et al **consists of** B) (*claimed component a*); A) and C) (A and C being *claimed component b*); D) and E) (D and E being *claimed component c*).

4. Claims 11, 12, 16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi et al (US 4,880,890) in view of Miki et al (US 5397638) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on August 3, 2004.

Response to Arguments

5. Applicants' arguments filed 1/05/2006 have been fully considered but they are not persuasive.

(A) Applicants argue that a hydroxyl-functional binder of Duecoffre is based on a hybrid polymer system of methacrylic copolymer and a hydroxy-functional polyester. Further, the methacrylic copolymer is prepared in the presence of the polyester polyol. The hybrid polymers used in Duecoffre are different from a simple physical mixture of a methacrylic copolymer and polyester polyol, as seen in the present invention. The Examiner suggests that the polyester described in Duecoffre is similar to the polyester polyol (a) of the present invention. However, Duecoffre's clear coat does not contain a polyester polyol, but instead contains a hybrid binder comprising polyester polyol as one part, and the methacrylic acid as the second part.

The Examiner respectfully disagrees with this argument. First of all, Duecoffre clearly teaches all components of claimed invention including B) separately from A) (See column 1, lines 41-60). Secondly, Duecoffre's clear coat does contain 80 wt % -60 wt % or less of a polyester polyol (a) of present invention, **in addition** to a hybrid binder comprising e.g. **at least 20 wt % -40 wt %** polyester polyol as one part in which the second part (i.e. the (methlacrylic copolymer portion) has been prepared by free-radical polymerization (See Abstract; column 1, lines 61-67; column 2, lines 34-36). Moreover, **claims 11 and 12 do not recite negative limitation about a hybrid binder**, i.e. the hybrid binder is not excluded from the composition of claims 11 and 12. See Tables and Example 5 and 6. Example 5 describes a simple physical mixture of a hybrid binder A of Example 3 **and** polyester polyol B of Example 1. Example 6 describes a simple physical mixture of a hybrid binder A of Example 4 **and** polyester polyol B of Example 1.

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(B) Applicants argue that Duecoffre does not teach the claimed quantitative composition of components (a1) and (a2) of the present invention, which require that the hydroxyl components and carboxyl components comprise no more than 20 wt-% of at least one diol and at least one monocarboxylic acid, respectively. To the contrary, Example 1 of Duecoffre comprises 57.8 M-% of monocarboxylic acid (isononanoic acid) among the carboxyl components and Example 2 of Duecoffre comprises 57 wt-% diol (hexane diol) among the hydroxyl components. In these Examples, both values (the 57.8 wt-% and 57 wt-%) are far above the upper limit disclosed in the present invention, which is 20 M-% in either case. This upper limit is set at 20 wt-% to ensure the high level of hydroxyl-functionality of the final polyester of the present invention.

The Examiner respectfully disagrees with this argument. First of all, it is held that patents are relevant as prior art for all they contain. NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. **Disclosed examples** and preferred embodiments do **not** constitute a **teaching away** from a **broad** disclosure or nonpreferred embodiments. See MPEP 2123. Therefore, examples 1 and 2 of Duecoffre do not teach away from a **broad** disclosure where amounts of claimed a1 and a2 are within claimed range, i.e. Duecoffre does teach the claimed quantitative composition of components (a1) and (a2).

(C) Applicants argue that although Duecoffre teaches that 0 to 40 wt% of dihydric alcohols of molecular weight range 62 to 2000 Da, and 0 to 60 wt% of monocarboxylic acid of molecular range 112 to 600 Da are used for preparing polyester polyols (See col. 14, lines 40-65), it neither gives a specific example that is within a claimed range of 0 to 20% of monocarboxylic acid component (corresponding to element (a2) in Claims 11 and 12), nor does it give a specific example that is within a claimed range of 0 to 20% of a diol (corresponding to element (a1) in

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Claims 11 and 12), as claimed by the present invention. According to MPEP 2131.03 (II)-Anticipation of Ranges, "When the **prior art** discloses a **range** which. . .**overlaps**. . . **the claimed range**, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation".

The Examiner respectfully disagrees with this argument. First of all, Duecoffre discloses a range which **covers** NOT **overlaps** the claimed range. The claimed range of **0 to 20%** is **within** the Duecoffre's range of **0 to 40 wt% or 0 to 60 wt%**.

It is held that "anticipation" requires that every element of the claims appear in a single reference. Therefore, Duecoffre teaching claimed range anticipates the claims.

(D) Applicants submit that a prima facie case of obviousness is not established because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings is not satisfied (See *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)). Specifically, neither Miyabayashi, nor Miki, express any suggestion or motivation to combine the two references to arrive at the claims of the present invention in question. Also, there is no likelihood or an expectation of success.

The Examiner respectfully disagrees with this argument. **Miyabayashi** et al teach that a thermosetting resin composition may be used for preparing precoated metals (See column 6, lines 47-50) by applying the **resin** composition to a metal substrate such as **alloyed zinc-plated steel** (See column 6, lines 54) after conventional **chromating** pre-treatment (See column 6, lines 59). The film also exhibits increased hardness as well as **high flexibility, stain resistance and chemical resistance** and can be utilized for, among others, **electrical appliances** (See column 7, lines 22-31). **Miki** et al teach that increasing requirements for more corrosion resistance than before in

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automotive bodies and household electric appliances are met by coating zinc alloy-plated steel sheets with a chromate layer and resin film (See column 1, lines 10-29). In other words, Miki et al is a secondary reference, which is relied upon to show that a method suitable for treating household electric appliances is also suitable for treating automotive bodies.

Thus, one of ordinary skill in the art would have been motivated and would have a reasonable expectation of success to apply a method of Miyabayashi et al suitable for household electric appliances for automotive bodies because Miki teaches that a method suitable for household electric appliances comprising steps of coating zinc alloy-plated steel sheets with a chromate layer and resin film is also suitable for automotive bodies.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER
E Tsoy

February 7, 2006